

## REMARKS

### FORMAL MATTERS:

Claims 1, 3, 6-16, 18, 21-34 are pending after entry of the amendments set forth herein.

Claims 1, 16, and 31 are amended. Support for these amendments is found in the claims as originally filed and throughout the specification at, for example, page 11, lines 7-24.

No new matter is added.

### REJECTIONS UNDER §103(A)

#### *Claims 1, 3, 6-11, 29, and 31*

Claims 1, 3, 6-11, 29, and 31 are rejected under 35 U.S.C. § 103(a) for allegedly being rendered obvious by Say et al. (U.S. Patent No. 6,103,033) in view of Charlton et al. (5,798,031). In view of the remarks made herein, this rejection may be withdrawn.

In making the rejection, the Office Action cites Say for teaching a biosensor having a conductive ink that includes once enzyme and a mediator. However, the Office Action specifically notes that “Say does not explicitly disclose the use of a polymer that provides a hydrophilic domain” in the conductive ink (Office Action, pages 2-3). To meet this deficiency, the Office Action cites Charlton for teaching deposition of a hydrophilic polymer over an electrode. The Office Action further concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was being made to utilize the teaching of Charlton for the sensor of Say.

In order to meet its burden in establishing a rejection under 35 U.S.C. §103(a), the Patent Office must first demonstrate that the combined prior art references teach or suggest all the claimed limitations. MPEP § 2143(A). In addition to demonstrating that all elements were known in the prior art, the Patent Office must also articulate a reason for combining the elements. See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct 1727 (2007) (“KSR”) at 1741; *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 243 Fed. Appx. 592, 595-596 (Fed. Cir. 2007) citing KSR; and *Innogenetics, N.V. v. Abbott Laboratories* 512 F.3d 1363, 1373, 85 USPQ2d 1641

(Fed. Cir. 2008). As such, a generalized motivation is not the kind of motivation required by the patent laws.<sup>1</sup>

As noted above, Say does not teach incorporation of the hydrophilic polymer in the conductive ink of the working electrode. In addition, the teaching of Charlton is limited to the deposition of the hydrophilic polymer in a reagent layer over the surface of electrodes (see column 1, lines 45-60). As such, similar to Say, Charlton also does not teach incorporation of the hydrophilic polymer in the conductive ink of the working electrode. The only teaching of incorporation of the hydrophilic polymer in a conductive ink is found in the present application.

At best, the combination of the teaching of Charlton with that of Say would result in a sensor as described in Say with a layer of hydrophilic polymer deposited over the electrode. The combination of references does not, as asserted by the Office Action, go further to teach incorporation of the hydrophilic polymer of Charlton into the conductive ink of Say. Likewise, there is no suggestion in the cited references that incorporation of the hydrophilic polymer in the conductive ink will allow the hydrophilic polymer to maintain its properties as well as allowing the conductive ink to maintain its properties. Without the use of the disclosure of the present application as a guide, there is no teaching or suggestion of incorporation of the hydrophilic polymer in the conductive ink. As such, the Office Action use of hindsight reconstruction to arrive at the presently claimed invention is improper.

In addition, Charlton also teaches away from incorporation of additional chemical moieties in the conductive ink, such as the hydrophilic polymer. In particular, Charlton teaches that the “components of the conductor ink are a mixture of carbon and silver, chosen to provide low chemical resistance path between the electrodes and the meter with which they are in operative connection” (column 2, lines 64-67). Therefore, a person having ordinary skill in the art would not be motivated to incorporate additional elements in the conductive ink as it could have an affect on the resistance path between the electrodes and the meter.

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<sup>1</sup> *Innogenetics, N.V. v. Abbott Laboratories* 512 F.3d 1363, 1373, 85 USPQ2d 1641 (Fed. Cir. 2008)

Therefore, since the combination of references fails to teach each and every element of the invention, namely incorporation of the hydrophilic polymer in the conductive ink, the cited references cannot render the pending claims obvious. As such, Applicants respectfully request that this rejection be withdrawn.

***Claims 1, 3, 6-16, 18, and 21-31***

Claims 1, 3, 6-16, 18, and 21-31 are rejected under 35 U.S.C. § 103(a) for allegedly being rendered obvious by Feldman (U.S. Patent No. 6,299,757) in view of Say and Charlton. In view of the remarks made herein, this rejection may be withdrawn.

As noted in the Office Action, both Say and Feldman do not teach incorporation of the hydrophilic polymer in the conductive ink of the working electrode. The Office Action turns to Charlton et al for teaching of a hydrophilic polymer. However, the teaching of Charlton is limited to the deposition of the hydrophilic polymer in a reagent layer over the surface of electrodes (see column 1, lines 45-60). Therefore, similar to Say and Feldman, Charlton also does not teach incorporation of the hydrophilic polymer in the conductive ink of the working electrode. The only teaching of incorporation of the hydrophilic polymer in a conductive ink is found in the present application.

At best, the combination of the teaching of Charlton with that of Say or Feldman would result in a sensor as described in Say or Feldman with a layer of hydrophilic polymer deposited over the electrode. The combination of references does not, as asserted by the Office Action, go further to teach incorporation of the hydrophilic polymer of Charlton into the conductive ink of Say or Feldman. Likewise, there is no suggestion in the cited references that incorporation of the hydrophilic polymer in the conductive ink will allow the hydrophilic polymer to maintain its properties as well as allowing the conductive ink to maintain its properties. Without the use of the disclosure of the present application as a guide, there is no teaching or suggestion of incorporation of the hydrophilic polymer in the conductive ink. As such, the Office Action use of hindsight reconstruction to arrive at the presently claimed invention is improper.

In addition, as noted above, Charlton also teaches away from incorporation of additional chemical moieties in the conductive ink, such as the hydrophilic polymer. In particular, Charlton teaches that the “components of the conductor ink are a mixture of carbon and silver, chosen to provide low chemical resistance path between the electrodes and the meter with which they are in operative connection” (column 2, lines 64-67). Therefore, a person having ordinary skill in the art would not be motivated to incorporate additional elements in the conductive ink as it could have an affect on the resistance path between the electrodes and the meter.

Therefore, since the combination of references fails to teach each and every element of the invention, namely incorporation of the hydrophilic polymer in the conductive ink, the cited references cannot render the pending claims obvious. As such, Applicants respectfully request that this rejection be withdrawn.

*Claims 32- 34*

Claims 32-34 are rejected under 35 U.S.C. § 103(c) for allegedly being rendered obvious by Feldman in view of Say and Charlton and further in view of Yamashita et al. (US Patent No. 5,472,590).

As noted above with respect to claims 1, 16 and 31, which claims 32-34 depend from, the combination of Feldman in view of Say and Charlton fails to teach incorporation of a hydrophilic polymer in the conductive ink of a sensor electrode. Yamashita has been cited for teaching the use of the hydrophilic polymer polyethylene glycol. However, Yamashita also fails to teach incorporation of a hydrophilic polymer in the conductive ink of a sensor electrode. Therefore, Yamashita fails to make up the deficiency of Feldman, Say and Charlton.

As such, the combination of cited references fails to teach each and every element of the claims and cannot render the present claims obvious. Therefore, Applicants respectfully request that this rejection be withdrawn.

**CONCLUSION**

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number ADCI-073.

Respectfully submitted,  
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Date: August 19, 2008

By: /Edward J. Baba, Reg. No. 52,581/

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